

REMARKS

The Amendments

Claims 1, 5, 8-12, 20-28, and 30 are pending after entry of the amendments set forth herein.

Claim 1 has been amended to add the limitations of canceled Claim 3. Claims 5, 9-11, and 30 are amended to change dependency from canceled Claim 3 to Claim 1. Claim 3 is canceled.

No new matter is added in any of the above amendments and the Examiner is respectfully requested to enter the amendments and reconsider the application.

The Response

Rejection Under §102

Claims 1, 8, and 23 have been rejected under 35 U.S.C. §102(b) for allegedly being anticipated by Pazo, et al., "HA-bioactive glass composites: high temperature reactivity and 'in-vitro' behavior", *Scripta Materialia* 34(11): 1729-1733 (1996). Applicants traverse this rejection in that amended Claim 1 recites "**a first intermediate layer having an inner and outer surface, and said first intermediate layer is located between the substrate and the first layer, said first intermediate layer comprises a glass composition**".

Pazo, et al. do not teach a first intermediate layer. As such, Pazo, et al. do not anticipate amended Claim 1, and Claims 8 and 23 which depend from Claim 1.

As such, the Applicants respectfully request the Examiner to withdraw this rejection.

Claims 1, 3, 5, 8-12, 20-28, and 30 have been rejected under 35 U.S.C. §102(a) for allegedly being anticipated by J.M. Gomez-Vega, E. Saiz, A.P. Tomsia, G.W. Marshall, and S.J. Marshall, "Glass-hydroxyapatite coatings on titanium-based implants", *Bioceramics: Materials and Applications III* pp. 15-23 (2000) (hereafter "the Glass-hydroxyapatite article"). Applicants traverse this rejection of Claims 1, 5, 8-12, 20-28, and 30 with the filing of a Declaration under 37 C.F.R. § 1.132 declaring that the Glass-hydroxyapatite article describes Applicants' own work. Claim 3 is canceled.

Where the applicant is one of the co-authors of a publication cited against his or her application, he or she may overcome the rejection by filing a specific affidavit or declaration under 37 C.F.R. § 1.132 establishing that the article is describing applicant's own work. An affidavit or declaration by applicant alone indicating that applicant is the sole inventor and that the others were merely working under his or her direction is sufficient to remove the publication as a reference under 35 U.S.C. § 102(a). *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982).

Applicants overcome this rejection by filing a Declaration under 37 C.F.R. § 1.132 declaring that the Glass-hydroxyapatite article describes Applicants' own work.

As such, the Applicants respectfully request the Examiner to withdraw this rejection.

Rejection Under §103

Claim 30 has been rejected under 35 U.S.C. §103(a) for allegedly being rendered obvious by the Glass-hydroxyapatite article and J.M. Gomez-Vega, E. Saiz, A.P. Tomsia, G.W. Marshall, and S.J. Marshall, "A multilayer approach to fabricate bioactive glass coatings on Ti alloys", *Mat. Res. Soc. Symp. Proc.* Vol. 550, pp. 349-354 (1999) (hereafter "the Multilayer article"). Applicants traverse this rejection in that the Glass-hydroxyapatite article is not a prior art and the Multilayer article alone does not render Claim 30 obvious.

The Multilayer article alone does not teach or suggest each and every element of Claim 30 as the Multilayer article neither teaches nor suggests (a) a first intermediate layer comprising a glass composition containing hydroxyapatite particles, or (b) an second intermediate layer. Accordingly, the Multilayer article fails to render Claim 30 obvious under 35 U.S.C. §103(a). As such, the Applicants respectfully request the Examiner to withdraw this rejection.

CONCLUSION

In view of the foregoing remarks and amendment, Applicants respectfully submit that all of the claims are in condition for allowance, which action is requested. If in the opinion of the Examiner, a telephonic conference would expedite the prosecution of the subject application, Applicants encourage the Examiner to call the undersigned at (510) 486-4534.

If any fee is required to maintain pendency of this application, the Commissioner is authorized to charge any necessary and additional fees, including fees for additional extensions of time, that may be due to Deposit Account No. 120690, referencing Attorney Docket: IB-1627.

Respectfully submitted,

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